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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,008	01/08/2002	Bernard Cuenoud	4-30970A	1967

1095 7590 07/21/2003

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EXAMINER

KIFLE, BRUCK

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/21/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>10/009,008</b>	Applicant(s) <b>Cuenoud et al.</b>	
	Examiner <b>Bruck Kifle, Ph.D.</b>	Art Unit <b>1624</b>	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  
 If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  
 If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  
 Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on Jun 24, 2003

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 17-37 is/are pending in the application.

4a) Of the above, claim(s) 18, 22, 24, 25, 30, and 37 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 17, 19-21, 23, 26-29, and 31-36 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a)  All b)  Some\* c)  None of:  
 1.  Certified copies of the priority documents have been received.  
 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
 a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 and 7

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

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*Election/Restriction*

Applicant's election of the compound of claim 29(A)ii in Paper No. 9 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The elected species was not found in the search and the search was expanded to embrace compounds, pharmaceutical compositions, methods of use and process of making compounds of formula I wherein "Ar" represents formula (III) along with the full scope of the other variables.

Claims 18, 22, 24, 25, 30, 37 along with subject matter not embraced by the searched group of the remaining claims are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group.

Note that compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive concept under PCT Rule 13.1, 37 CFR 1.475(d). The instant claims are not so linked as to form a single inventive concept. The compounds of formula I are so diverse in scope that a prior art anticipating one compound under 35 USC 102 would not render obvious another compound of the same claim under 35 USC 103. Claims 30 and 37 are of a different scope.

*Abstract*

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

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***Claim Rejections - 35 USC § 112***

Claims 17, 19-21, 23, 26-29 and 31-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) In the definitions of the "R" groups, it is not known which and how many hetero atoms interrupt the alkyl groups.
- ii) The term "heterocyclic" is indefinite because it is not known how many atoms make up the ring, which atoms are present and what kind of a ring (monocyclic, bicyclic, spiro, fused, bridged, saturated, etc.) is intended.
- iii) In claim 30, the compounds under group (C) are written in a way that one can not readily identify the individual compounds. It is suggested to present the compounds on different lines separated by semicolons so that the printer does not make mistakes when the patent issues.
- iv) In claim 33 it is unclear which condition is prevented or alleviated by activation of the  $\beta$ 2-adrenoreceptor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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July 18, 2003

  
**Bruck Kifle**  
**Primary Examiner**  
**Art Unit 1624**